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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,005	10/16/2003	Stacy R. Kaufman	43089-0016	7450
53437	7590	09/14/2006		
ROBERT M. SCHWARTZ, P.A. P.O. BOX 221470 HOLLYWOOD, FL 33022			EXAMINER HENDERSON, MARK T	
			ART UNIT 3722	PAPER NUMBER

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,005

Applicant(s)

KAUFMAN, STACY R.

Examiner

Mark T. Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 15-19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED OFFICE ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1-14 have been canceled. Claims 15-19 have been added.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 15-19 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Levine et al in view of Shigeki (JP-2000-098903).

Levine et al discloses label roll comprising a front printing face (26a) with an adhesive backing (42), consecutive perforated tear lines (22) spaced apart (see Fig. 1) at a distance greater than a perimeter of a support item for defining an individual label section; a backing liner (40); wherein the label section further has a score line (39) defining a border between a first portion (24) and a second portion (26).

However, Levine et al does not disclose: a first portion having a length corresponding to a perimeter of a container; wherein the second portion projects from a container, and wherein the first portion is attached to the container; wherein the backing sheet liner has a score line formed therein corresponding to the score line in the front face; wherein the front face and backing sheet includes a further score line; wherein the roll is formed of thermal paper.

Shigeki discloses in Fig. 1, 2 and in Attachment I, a label comprising a face sheet (1) and a backing liner (5); a first portion (4) having a length corresponding to a support item (10), wherein the first portion (4) is attached to the support item (see English abstract); wherein a second portion (2a) and a corresponding third portion (2B) projects from the support item (see abstract and Fig. 2); wherein the backing liner (5) has a score line (6D) formed corresponding to the score line (1D) in the front face (1); wherein the front face and backing liner include a further score line (1C and 6C).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Levine et al's label with a front face having score lines and a

corresponding back liner having corresponding score lines as taught by Shigecki for providing an alternative label form having a display tag portion.

In regards to Claim 15 and 19, wherein the label roll is “for placement on a medicinal container, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the label roll of Levine et al and Shigecki can be used for placement on a medicinal container.

In regards to **Claim 18**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the label roll out of any desirable material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Therefore, it would have been obvious to construct the label roll with any desired paper material, since applicant has not disclosed the criticality of using a particular material, and invention would function equally as well with any desired material.

Response to Arguments

Applicant's arguments with respect to claims 15-19 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's arguments that the prior art does not disclose the amended claimed invention, the examiner submits that Levine et al in view of Shigeki now disclose a blank label roll comprising used form placement around a support item, wherein the Shigeki reference is used for disclosing a label having a first and second face portions having perforated score lines;-and further having a backing liner with corresponding perforated score lines. In regards to label being used for placement around a container, since applicant did not positively claim in detail as to the structure of the container in combination with the label structure, therefore the examiner interpreted this limitation as an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the label roll of Levine et al and Shigeki can be used for placement on a medicinal container.

Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Van Bever discloses a similar label sheet.

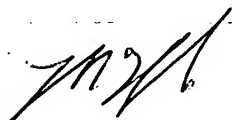
Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Monica Carter, can be reached at (571) 272-4475. The formal fax number for TC 3700 is (571) 273-8300.



MTH

September 10, 2006



MONICA CARTER
SUPERVISORY PATENT EXAMINER